

REMARKS/ARGUMENTS

Claims 11, 13-17, and 19-22 are pending in this application. By this Amendment, Applicant AMENDS claims 11 and 17.

Applicant appreciates the Examiner extending the courtesy of the brief telephone interview on October 16, 2009. During the telephone interview, the Examiner explained the meaning of the fourth paragraph on page 5 of the outstanding Office Action by alleging that as long as two elements overlap, the perspective or the direction in which the elements overlap is valid for both a lateral side view and a plan view.

Although Applicant does not understand the logic of the Examiner's reasoning, and strongly disagrees with the Examiner's allegation that as long as two elements overlap then the perspective of the overlap is essentially irrelevant, Applicant has amended claims 11 and 17 only to clarify the relative orientation of the filter, the cylindrical pump body, and the mounting plate. Applicant respectfully submits that the amendments to claims 11 and 17 do not raise any new issues as they only restate the orientation of the filter, the cylindrical pump body, and the mounting plate in terms of first and second directions, in addition to the lateral and plan views of the vehicle.

Claims 11 and 17 were objected to for containing a minor informality (Applicant notes that the Examiner inadvertently listed canceled claim 1 instead of claim 11). Applicant has amended claims 11 and 17 to correct the minor informality noted by the Examiner. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the objection to claims 11 and 17.

Claims 11-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ootaka et al. (U.S. 6,679,292) in view of Suzuki et al (JP 2003-074436) and Kobayashi et al. (U.S. 6,655,363) (Applicant notes that the Examiner inadvertently included claims 12 and 18 in the introductory sentence although claims 12 and 18 have been canceled by Applicant).

Applicant respectfully traverses the rejection of claims 11, 13-17, and 19-22.

Claim 11 has been amended to recite:

A mounting structure for a fuel pump of a vehicle engine, the mounting structure comprising:

a fuel pump assembly including a cylindrical pump body and a filter coupled with a suction end of the pump body;

a fuel tank arranged to straddle a body frame of a vehicle;

a housing enclosing the cylindrical pump body, a flange section of the housing arranged to abut an outside area surrounding an opening in the fuel tank; and

a mounting plate arranged to cover the flange section on an outside of the fuel tank, the fuel pump assembly arranged to be fixed to the opening through the mounting plate and the flange section; wherein

an axis of the cylindrical pump body extends generally parallel to a mounting surface of the mounting plate;

**the cylindrical pump body and the filter are arranged to overlap each other in a first direction corresponding to a plan view of the vehicle;**

the opening is arranged in a side wall surface of the fuel tank, the mounting plate is attached to the opening of the side wall surface of the fuel tank; and

**the mounting plate and the cylindrical pump body at least partially overlap each other in a second direction corresponding to a lateral side view of the vehicle, the second direction being substantially perpendicular to the first direction.** (emphasis added)

Applicant's claim 17 has been amended to recite features that are similar to the features recited in Applicant's claim 11, including the above-emphasized features.

The Examiner alleged that Ootaka et al. teaches a fuel pump assembly 20, a housing 22 enclosing the fuel pump assembly, and a mounting plate 40 arranged to cover a flange section of the housing. The Examiner acknowledged that Ootaka et al. does not teach a filter or that the cylindrical pump body extends generally parallel to a mounting surface of the mounting plate, but alleged that Suzuki et al. teaches a cylindrical pump body P having a filter F such that the cylindrical pump body P extends generally parallel to a mounting surface T and arranged to overlap the filter F. The Examiner alleged that it would have been obvious to provide Ootaka et al. with an elongated cylindrical pump and filter in order to reduce the size of the opening in the fuel tank. Although Suzuki et al. clearly shows in Fig. 1 that the filter F is arranged below the cylindrical pump body P, the Examiner alleged in the last sentence on page 4

of the Office Action that it would have been obvious “to reorient the filter such that it is below the cylindrical pump body based upon mounting location in order to maximize the use of internal fuel tank volume.” Lastly, the Examiner alleged that Kobayashi et al. teaches a fuel pump assembly arranged in an elliptical opening in a side wall surface of the fuel tank, and that it would have been obvious to modify the opening of Ootaka et al. to have an elliptical opening in order to allow installation of the fuel pump assembly in low-profile tank shapes.

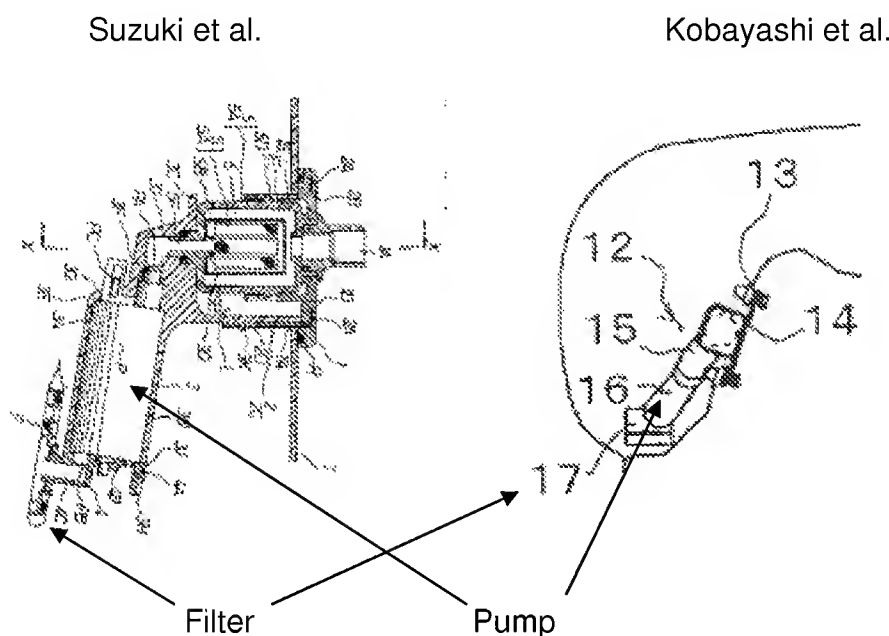
Applicant respectfully disagrees for the following reasons.

As stated above, the Examiner alleged that it would have been obvious to reorient a fuel filter such that it is below a cylindrical pump body based upon the mounting location of the fuel assembly in the fuel tank in order to maximize the use of internal fuel tank volume. However, since Suzuki et al. clearly shows in Fig. 1 that the filter F is arranged below the cylindrical pump body P, it is not clear how the Examiner's allegation is relevant to modifying the fuel pump assembly of Suzuki et al.

To cure the deficiencies of Ootaka et al. and Suzuki et al., the Examiner relied upon Kobayashi et al. for the teaching of a fuel pump assembly mounted to a side wall surface of a fuel tank (see, for example, Fig. 2 of Kobayashi et al.). As clearly seen in Fig. 2 of Kobayashi et al. (reproduced on the right below), the fuel filter 17 is arranged below the fuel pump body 16 such that the fuel filter 17 is arranged at the bottom of the fuel tank in order to maximize the use of internal fuel tank volume.

Assuming *arguendo* that one of ordinary skill in the art would have been motivated to modify the mounting location of the fuel pump assembly of Ootaka et al. as modified by Suzuki et al. in view of the teachings of Kobayashi et al., Applicant respectfully submits that the fuel pump assembly of Suzuki et al. (reproduced on the left below) could simply be mounted to a side wall surface of a fuel tank without reorienting the fuel filter F with respect to the cylindrical pump body P, as alleged by the Examiner. As clearly shown below, the fuel filter F of Suzuki et al. would still be arranged at the bottom of the fuel tank in order to maximize the use of internal fuel tank volume when the fuel pump assembly of Suzuki et al. is mounted on a side wall surface of a fuel tank.

In fact, because the orientation of the fuel filter with respect to the cylindrical pump body in each of Suzuki et al. and Kobayashi et al. are remarkably similar, there would have been absolutely no logical reason to reorient the filter with respect to the cylindrical pump body in the fuel pump assembly of Suzuki et al., as alleged by the Examiner.



Instead of basing the conclusion of obviousness on actual teachings or suggestions of the prior art and the knowledge of one of ordinary skill in the art at the time the invention was made, the Examiner has improperly used Applicants' own invention as a guide. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. The Federal Circuit has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992).

Furthermore, none of Ootaka et al., Suzuki et al., and Kobayashi et al. remotely teaches or suggests the desirability or necessity of providing a compact fuel pump

assembly that reduces the moment of a fuel pump assembly mounted to a side wall surface of a fuel tank (see, for example, paragraph [0003] of Applicant's substitute specification filed June 19, 2006). That is, none of Ootaka et al., Suzuki et al., and Kobayashi et al. teaches or suggests the unique and unexpected benefits achieved by Applicant's claimed invention.

Accordingly, Applicant respectfully submits that, without using the benefit of Applicant's own disclosure, there is no proper motivation to reorient the filter with respect to the cylindrical pump body in the fuel pump assembly of Suzuki et al., as alleged by the Examiner.

Thus, the combination of Ootaka et al., Suzuki et al., and Kobayashi et al. fails to teach or suggest the features of "the cylindrical pump body and the filter are arranged to overlap each other in a first direction corresponding to a plan view of the vehicle" and "the mounting plate and the cylindrical pump body at least partially overlap each other in a second direction corresponding to a lateral side view of the vehicle, the second direction being substantially perpendicular to the first direction," as recited in Applicant's claim 11, and similarly in Applicant's claim 17.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 11 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Ootaka et al. in view of Suzuki et al. and Kobayashi et al.

Applicant respectfully requests entry of this Amendment because claim 17 does not present any new issues requiring further consideration or search by the Examiner because claim 17 has been amended only to include features previously recited and considered by the Examiner with respect to claim 11. See M.P.E.P. § 714.13.

In view of the foregoing amendments and remarks, Applicant respectfully submits that claims 11 and 17 are allowable. Claims 13-16 and 19-22 depend upon claims 11 and 17, and are therefore allowable for at least the reasons that claims 11 and 17 are allowable.

In view of the foregoing amendments and remarks, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt

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allowance are solicited.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

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